REMARKS

Applicants appreciate the continued examination as evidenced by the Office Action dated June 11, 2008 (the "Action").

I.   Allowed Subject Matter and New Dependent Claims

Applicants appreciate the indication in the Action that Claims 10, 30, 50, 65 and 79 are allowed.

Claims 87-111 are new. Support for Claims 87-111 can be found in the specification, for example, page 15, line 25 – page 16, line 19; Figure 11; and original Claims 4-5 and 16-17.

Claims 87-111 depend from allowed Claims 10, 30, 50, 65 and 79. Accordingly Claims 87-111 are also in condition for allowance at least per the allowability of Claims 10, 30, 50, 65 and 79, which action is respectfully requested.

II.   The 35 U.S.C. 112 Rejections

Claims 20-29, 31-39, 60-64 and 66-73 stand rejected under 35 U.S.C. 112, first paragraph. The Action states that Claims 20 and 60 are single step claims that fail to comply with the enablement requirement. The only legal support for the 35 U.S.C. 112 rejection that is provided in the Action is MPEP 2164.08(a). As discussed in Applicants' paper submitted March 25, 2008, MPEP 2164.08(a) states that a single _means_ claim (_i.e._, where a _means_ recitation does not appear in combination with another recited element or means) can be subject to a rejection under 35 U.S.C. 112, first paragraph. Applicants submit that MPEP 2164.08(a) clearly applies only to a single means claim. Claim 20 is directed to a method and Claim 60 is directed to a computer program product, and therefore, the provisions of MPEP 2164.08(a) do not apply to Claims 20 and 60. Moreover, support for the recitations of Claims 20 and 60 are enabled by the application as filed, _e.g._, on page 9, lines 6-33.

Accordingly, Applicants request that the rejections of Claims 20-29, 31-39, 60-64 and 66-73 under 35 U.S.C. 112 be withdrawn. However, if the rejections under 35 U.S.C. 112 are

maintained, Applicants respectfully request that the legal authority relating to <u>single step</u> or <u>computer program product claims</u> be specifically identified.

III.   The 35 U.S.C. 103(a) Rejections

Claims 1-9, 11-29, 31-49, 51-64, 66-78 and 80-86 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz et al. ("Munoz") in view of U.S. Patent No. 7,058,584 to Kosinski et al. ("Kosinski").

A.   The Independent Claims

The Action concedes that Munoz fails to disclose querying at least one database using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message. The Action takes the position that Kosinski teaches this recitation at column 20, lines 37-59.

The cited portions of Kosinski discuss a prescription processing database that is queried to <u>locate a prescription number</u> entered by the caller (step S230). If the prescription number is found, then <u>a verification message</u> is played for the caller (step S234). *See* Kosinski, **Figure 1** (reproduced below).
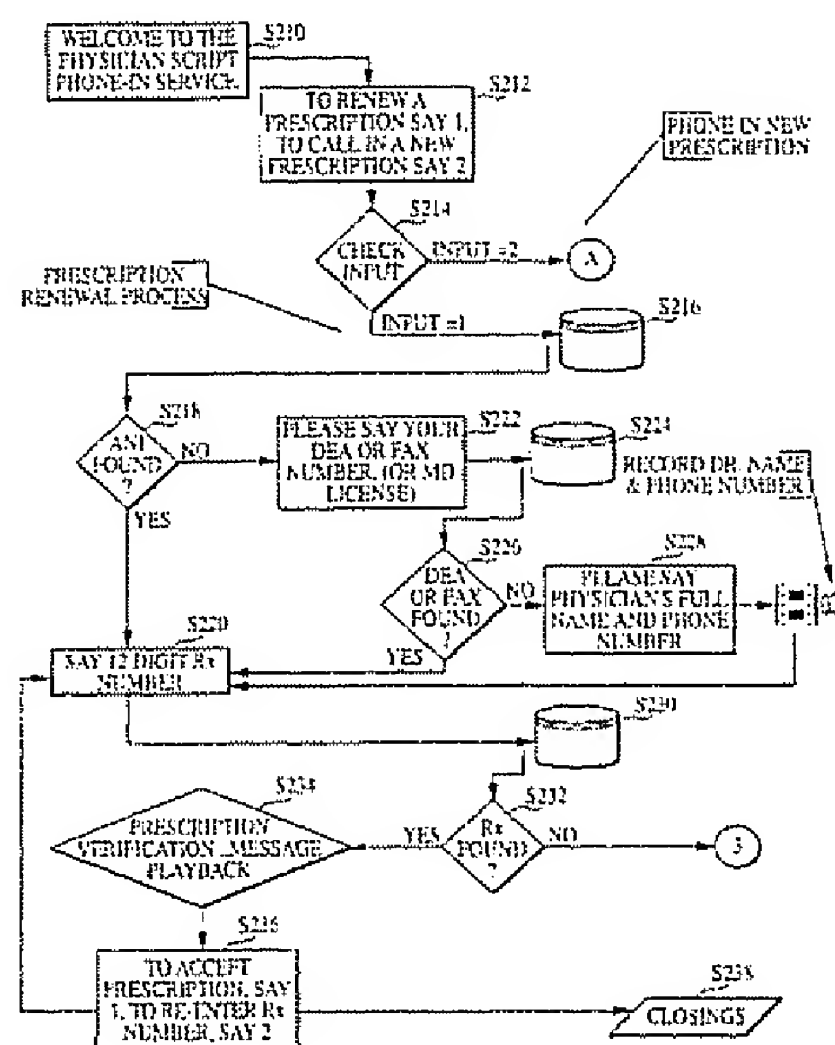

FIG. 6A

In contrast, the independent claims generally recite "<u>querying at least one database</u> <u>using predefined criteria based on the identification of a pharmaceutical prescription to</u> <u>identify a targeted message</u>" (*see, e.g.*, Claim 1) or "<u>identifying a targeted message for playing</u> <u>to the caller using predefined criteria that are based on an identification of a pharmaceutical</u> <u>prescription by the caller</u>" (*see, e.g.* Claim 20).

As discussed above and as shown in **Figure 6A**, Kosinski merely identifies a prescription and plays a verification message. The Action apparently takes the position that the verification message of Koskinski is analogous to the targeted message recited in the independent claims. However, as shown in **Figure 6A**, Kosinski queries a database S230 to identify a prescription. Applicants submit that there is no predefined criteria used to identify a targeted message in Kosinski. Moreover, the verification of the identification of the prescription is merely part of conventional techniques for accepting an identification of a pharmaceutical prescription. However, the verification step of Kosinski clearly does not <u>identify a targeted message using predefined criteria that are based on an identification of a</u> <u>pharmaceutical prescription</u>. In addition, Kosinski does not <u>query a database using</u> <u>predefined criteria based on the identification of a pharamceutical prescription to identify a</u> <u>targeted message</u>.

Therefore, the verification step S234 of Kosinski also does not meet the recitations of the independent claims, including at least the recitations emphasized in the independent claims as follows:

      1.   A method of operating a pharmacy Interactive Voice
Response (IVR) system comprising:
      answering a telephone call from a caller;
      accepting identification of a pharmaceutical prescription from
the caller;
      <u>querying at least one database using predefined criteria based</u>
<u>on the identification of a pharmaceutical prescription to identify a</u>
<u>targeted message</u>; and
      playing the targeted message to the caller.

      20.   A method for operating a pharmacy Interactive Voice
Response (IVR) system in response to a telephone call by a caller to
the pharmacy IVR system comprising:

identifying a targeted message for playing to the caller using
predefined criteria that are based on an identification of a
pharmaceutical prescription by the caller.

40.   A system for operating a pharmacy Interactive Voice
Response (IVR) system comprising:
        at least one database; and
        a module that is configured to query the at least one database
using predefined criteria based on an identification of a pharmaceutical
prescription from a telephone caller to the pharmacy IVR system, to
identify a targeted message based on the predefined criteria and to
provide the targeted message to the pharmacy IVR system for playing
to the caller.

60.   A computer program product is configured to operate a
pharmacy Interactive Voice Response (IVR) system in response to a
telephone call by a caller to the pharmacy IVR system, the computer
program product comprising a computer usable storage medium
having computer-readable program code embodied in the medium, the
computer-readable program code comprising:
        computer-readable program code that is configured to identify a
targeted message for playing to the caller using predefined criteria that
are based on an identification of a pharmaceutical prescription by the
caller.

74.   A pharmacy Interactive Voice Response (IVR) system
comprising:
        means for answering a telephone call from a caller;
        means for accepting identification of a pharmaceutical
prescription from the caller;
        means for querying at least one database using predefined
criteria based on the identification of a pharmaceutical prescription to
identify a targeted message; and
        means for playing the targeted message to the caller.

Accordingly, Applicants respectfully submit that the recitations of independent Claims 1, 20,

40, 60 and 74 are not disclosed by Munoz and/or Kosinski, and therefore, a *prima facie* case

of obviousness has not been made. Claims 2-9, 11-19, 21-39, 41-49, 51-59, 61-64, 66-73, 75-

78 and 80-86 depend from Claims 1, 20, 40, 60 and 74 and are patentable at least per the

patentability of the independent claims. Accordingly, Applicants request that the rejection of Claims 1-9, 11-49, 51-64, 66-78 and 80-86 be withdrawn.

In addition, Applicants submit that certain dependent claims are separately patentable for at least the reasons that follow.

B. Dependent Claims 18, 38, 58, 73 and 86

Dependent Claims 18, 38, 58, 73 and 86 generally recite querying at least one pharmacy dispensing system database using the identification of the pharmaceutical prescription to identify the predetermined criteria and querying at least one message database using the predetermined criteria to identify a targeted message.

As discussed above, Kosinski does not query a database using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message. Kosinski also does not disclose querying a pharmacy dispensing system database and querying at least one message database. The cited portions of Kosinski discuss a prescription processing database that is queried to locate a prescription number entered by the caller (step 230, Figure 6A), and if the prescription number is found, then a verification message is played for the caller (step 234, Figure 6A). However, a message database is not queried to identify a targeted message.

For at least these reasons, a *prima facie* case of obviousness has not been made with respect to Claims 18, 38, 58, 73 and 86. Applicants submit that Claims 18, 38, 58, 73 and 86 are separately patentable and respectfully request an indication of same.

C. Dependent Claims 7-9, 27-29, 47-49, 62-64, and 77-79

Dependent Claims 7-9, 27-29, 47-49, 62-64, and 77-79 depend from Claims 1, 20, 40, 60 or 74 and are patentable for at least the reasons discussed above. In addition, Claims 7-9, 27-29, 47-49, 62-64, and 77-79 are separately patentable for at least the reasons that follow.

The Action takes the position that Munoz discloses the recitations of Claims 7-9, 27-29, 47-49, 62-64 and 77-79 in paragraphs [0044] – [0045]. The recitations of Claims 7-9, 27-20, 47-49, 62-64 and 77-79 are summarized below:

- the predefined criteria are based on the identification of a pharmaceutical prescription and include the age of the patient who is using the pharmaceutical prescription, gender of the patient, medication of the pharmaceutical prescription, last filled date of the pharmaceutical prescription, days supply on last fill a pharmaceutical prescription, original filled date of the pharmaceutical prescription, disease state of the patient, physician of the patient and/or other promotions in effect (Claim 7, 27, 47, 62 and 76)

- the predefined criteria based on the identification of a pharmaceutical prescription do not include a personal identification of a patient who is using the pharmaceutical prescription (Claim 8, 28, 48, 63 and 77)

- the predefined criteria based on the identification of a pharmaceutical prescription includes the age of the patient, gender of the patient, medication of the pharmaceutical prescription, last filled date of the pharmaceutical prescription, days supply on last fill a pharmaceutical prescription, original filled date of the pharmaceutical prescription, disease state of the patient, physician of the patient and/or other promotions in effect but do not include a personal identification of a patient who is using the pharmaceutical prescription (Claim 9, 29, 49, 64 and 78)

In contrast, paragraphs [0044] – [0045] of Munoz merely discuss comparing the identification information provided by the caller to a database. Paragraphs [0044] – [0045] of Munoz are reproduced below (emphasis added):

> [0045] If the caller confirms their identity by depressing the "1" key in step 154 or in step 144, then he moves onto step 146 where the system asks the caller to begin to identify the patient by typing in the first three letters of the patient's last name. Next, in step 148, the system asks the caller to type in the patient's date of birth. This information is unique to every patient and can be used by the system to positively establish a patient's identity. In step 150, the system compares this information to a database of all patients and speaks the patient's name to the caller. The caller presses "1" to confirm the patient's identity or "2" to deny the patient's spoken identity. If the caller denies the patients spoken identity, the caller is asked to enter the patient's social security number in step 158. The social security number is unique to

every patient and can be used by the system to establish identity. The caller presses "1" to confirm the patients identity or "2" to deny the patient's spoken identity. If the caller denies the patient's spoken identity for a second time (step 160), the system tells the caller that the patient is not listed in the patient database and terminates the call (step 162).

[0046] If the caller accepts the patient identity in step 150, he is asked to enter the 13 digit NDC number of the medication for which he requires a prescription (step 164). In step 166 the caller is asked to confirm the drug's spoken identity. If the caller denies the drug's spoken identity by pressing the "2" key in step 166, he is asked to reenter the drugs 13 digit NDC number in step 168. In step 170 the caller is again asked to confirm the spoken name of the drug. If the caller denies the spoken identity of the drug for a second time, the system tells the caller that the drug cannot be identified and terminates the call (step 172).

Munoz clearly does not identify a targeted message based on the predefined criteria recited in Claims 7-9, 27-29, 47-49, 62-64 and 77-79 and summarized above (*e.g.*, age of the patient, gender of the patient, etc. and/or not including personal identification) in paragraphs [0044] – [0045]. Paragraphs [0044]-[0045] are the only portions of Munoz cited in the Action with respect to Claims 7-9, 27-29, 47-49, 62-64 and 77-79.

Notably, Claims 8-9, 28-29, 48-49, 63-64 and 78-79 recite that the predefined criteria do not include a personal identification of a patient who is using the pharmaceutical prescription. The cited portions of Munoz discuss confirming the identity of the caller. Therefore, Munoz teaches away from the recitations of Claims 8-9, 28-29, 48-49, 63-64 and 78-79.

For at least these reasons, Applicants submit that a *prima facie* case of obviousness has not been made with respect to Claims 7-9, 27-29, 47-49, 62-64 and 77-79, and that such claims are separately patentable. An indication of the separate patentability with respect to Claims 7-9, 27-29, 47-49, 62-64 and 77-79 is respectfully requested.

D. Dependent Claims 11-17, 31-37, 51-57, 66-72 and 80-85

The Action takes the position that the recitations of Claims 11-17, 31-37, 51-57, 66-72 and 80-85 are disclosed in Kosinski at column 20, lines 37-59. However, the cited portions of Kosinski merely discuss the verification messages discussed above with respect to the independent claims. The cited portion of Kosinski is reproduced below:

> The caller is prompted to submit the 12 digit number of the prescription being renewed. At step S230, the prescription processing system database is queried to locate the prescription number. If the prescription number cannot be found, then control passes to block B. If the prescription number is found, then a verification message is played for the caller at step S234 in order to confirm that the appropriate prescription number was submitted. At step S236, the caller provides an indication of whether he or she would like to accept the prescription number or resubmit a new prescription number. If the caller would like to resubmit the prescription number, then he or she can say or input the word "2" and control returns to step S220. If the prescription number is accepted, then control passes to step S238 where the caller is directed to the closings section. Callers who are submitting new prescription requests are directed to step S240 where the prescription processing system database is queried for the physician ANI number. As previously discussed, the ANI number can be submitted, cross-referenced, etc. Similar to the procedure for renewing prescriptions, if the ANI number is not found at step S242, then control passes to step S236. The caller is prompted to say the DEA or fax number of the prescribing physician.

Applicants submit that the cited portion of Kosinski clearly does not disclose the following recitations of Claims 11-17, 31-37, 51-57, 66-72 and 80-85:

- the targeted message includes an educational message concerning the pharmaceutical prescription, a message that indicates alternative medications that may be substituted for the pharmaceutical prescription, a message that identifies other items that made be desired and/or a message that solicits participation in a study related to the pharmaceutical prescription (Claim 11, 31, 51, 66 and 80)

- identifying an educational targeted message concerning the pharmaceutical prescription (Claim 12, 32, 52, 67 and 81)

- identifying <u>an educational targeted message</u> that reminds the caller how to use the pharmaceutical prescription if the last filled date is less than a first threshold and the days supply on the last filled date is greater than a second threshold (Claim 13, 33, 53, 68 and 82)

- identifying <u>a targeted message that indicates alternative medications that may be substituted</u> for the pharmaceutical prescription if the last filled date is less than a first threshold and the days supply on last filled date exceeds a second threshold (Claim 14, 34, 54, 69 and 83)

- identifying <u>a targeted message that indicates other items that may be desired if the gender is female, age exceeds a first threshold, the last filled date is less than a second threshold and the days supply on the last filled date exceeds a third threshold</u> (Claim 15, 35, 55, 70 and 84)

- identifying <u>a targeted message that solicits participation of the patient in a study</u> related to the pharmaceutical prescription if the age of the patient qualifies the patient to participate in a study related to the pharmaceutical prescription (Claim 16, 36, 56, 71 and 85)

- providing <u>additional targeted messages to allow the patient to participate in the study</u> if the patient agrees to participate (Claim 17, 37, 57 and 72)
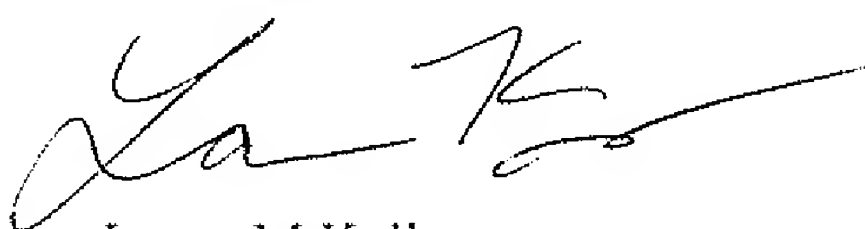
Accordingly, Applicants submit that a *prima facie* case of obviousness has not been met with respect to Claims 11-17, 31-37, 51-57, 66-72 and 80-85. Therefore, Claims 11-17, 31-37, 51-57, 66-72 and 80-85 are separately patentable, and Applicants request an indication of same.

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CONCLUSION

Accordingly, Applicant submits that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any small matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,

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